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EXAMINER

GRANT II, JEROME

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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2624

DATE MAILED: 06/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/218,335

Applicant(s)

Omi

Examiner

Grant

Art Unit

2624



- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Sep 3, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 12-47 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 12-47 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

EROME GRANT II
PRIMARY EXAMINER

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☒ Interview Summary (PTO-413) Paper No(s). 13 (A+B)

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

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1.

In view of a more recent court decision, the examiner is withdrawing the finality of the rejection for the consideration of **Jaswant S. Pannu and Jaswant S. Pannu, M.D., P.A., v. Storz Instruments, INC.** (CAFC July 25, 2001). A copy is provided herein. Pre-existing case law will be cited in the rejection as well.

2. Claims 12-47 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based.

The CAFC, in the Pannu case, decided that the reissue application, in the instant case, improperly broadened claims in manner directly pertinent to subject matter **surrendered during the prosecution.**

Pannu filed a supplemental amendment that cancelled claims and added new claims. Similarly, the applicant in the instant case, added new claims which contained limitations which were added in the new claims as well as the old independent claims.

The court explained:

“The recapture rule ‘prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.’ **Clement**, 131 F.3d at 1468 USPQ2d at 1164. Reissue claims that are broader than the original patent’s claims in a

✱ manner directly pertinent to the subject matter surrendered during prosecution are impermissible. **Mentor Corp. V. Coloplast**, Inc 998 F.2d 992, 995, 27 USPQ 2d 1521, 1524 Fed. Cir. 1993).

Application of the recapture rule is a three-step process. The first step is to ‘determine whether

1 (and in what *aspect* the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter.) 2
3 Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. **Hester**, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; **Clement**, 131 F.3d at 1470, 45 USPQ 2d 1165.”

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Moreover, this court restated: A REISSUE CLAIM THAT DOES NOT INCLUDE A LIMITATION PRESENT IN THE ORIGINAL PATENT CLAIMS IS BROADER IN THAT RESPECT. Hester, Id.

In the instant case, the limitations which were added to claim 1, by the amendment received June 17, 1996, overcame the examiner's rejection and placed the application in condition for allowance. This is subject matter which applicant "surrendered" **in order to get the application allowed.**

Because, the reissued application improperly broadened claims in a manner directly pertinent to subject matter (see the amendment of claims received June 12, 1996) surrendered during prosecution, the "recapture rule" bars patenting these claims.

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Rejections based on Older Case Law

As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In a recent court decision, *In re Clement* (CAFC), 45 USPQ 2d 1161, the court used a three part test to determine the relevance of a prior art rejection in determining when claims in a reissue application may be properly broadened. See *Mentor Corp. V. Coloplast, Inc* 998 F.2d 992, 27 USPQ 2d 1521, (Fed. Cir. 1993) & *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984).

From the courts reasoning, the following principles were applied:

1) if the reissue claim is as broad as or broader than the canceled or amended claim, in all aspects, the recapture rule bars the claim; 2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; 3) if the reissue claim is broader in some aspects, but narrower in other, then: a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, by narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; b) if the reissue claim is narrowing in an aspect germane to prior art rejection, and boarder in an aspect unrelated to the rejection, the recapture rule doe not bar the claim, but other rejections are possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is (703) 305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on (703) 308-7254. The fax phone number for this Group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

J. Grant II
March 13, 2009
PRIMARY EXAMINER